



17 OCT 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

BIRCH, STEWART, KOLASCH & BIRCH, LLP  
P.O. Box 747  
Falls Church, VA 22040-0747

In re Application of :  
HIGASHI, Mitsuhiro *et al* :  
Application No.: 09/555,255 :  
PCT No.: PCT/JP99/05273 :  
Int. Filing Date: 28 September 1999 :  
Priority Date: 28 September 1998 :  
Attorney Docket No.: 1155-0198P :  
For: ORTHOALKYLATION CATALYST FOR :  
PHENOL AND PROCESS ...

## DECISION

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)" filed 25 July 2003 and "Supplemental Petition for Revival" filed 10 September 2003.

### BACKGROUND

On 17 July 2003, a communication was mailed notifying applicants that the above-captioned application was abandoned for failing to meet the requirements of 35 U.S.C. 371. A copy of the international application was not submitted to the USPTO until after the commencement of the national stage on 28 May 2000. It was also noted that applicants' explanation regarding the difference in spelling of the last name of the first inventor submitted on 07 May 2002 was a transliteration error and this explanation met the requirements of section 201.03 of the MPEP.

On 25 July 2003, applicants filed a petition to revive for an unintentional abandonment pursuant to 37 CFR 1.137(b) which was accompanied by, *inter alia*, a petition fee of \$650.00

On 14 August 2003, the International Bureau (IB) submitted a letter to Mr. Leonard Smith of the USPTO regarding their failure to transmit a copy of the international application to the USPTO as a designated Office.

On 10 September 2003, applicants filed a supplemental petition to revive requesting that consideration be given to converting the 25 July 2003 petition to an unavoidable petition under 37 CFR 1.137(a) which was accompanied by, *inter alia*, a copy of the 14 August 2003 letter to the USPTO.

### DISCUSSION

Applicants request that the above-captioned petition be considered first under

the unavoidable standard of 37 CFR 1.137(a). A petition to revive an abandoned application on the grounds that the failure to timely reply was unavoidable pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4) the petition fee.

Here, applicants argue that the abandonment was unavoidable because the failure to communicate a copy of the international application to the USPTO was the fault of the IB. In support of this claim, applicants provided a copy of a letter dated 14 August 2003 from the IB to the USPTO which states that "the International Bureau, pursuant to PCT Article 20(1)(a) and Rule 47.1(a) and (b), should have communicated a copy of the international application to the designated Office. The Article 20 communication should have taken place within the time limit . . . due to an oversight, the international Bureau failed to send a copy of the international application to the USPTO as a designated Office within that time limit."

After a careful review of the evidence, it is concluded that this situation meets the unavoidable standard of 37 CFR 1.137(a). The petition fee has been paid. No terminal disclaimer is required. Accordingly, all requirements of 37 CFR 1.137(a) have been satisfied.

### CONCLUSION

Applicants' petition under 37 CFR 1.137(a) is **GRANTED**.

Applicants paid a \$650.00 petition fee on 25 July 2003. The fee for a petition to revive pursuant to 37 CFR 1.137(a) is \$55.00. Accordingly, the difference of \$595.00 has been credited to applicants' Deposit Account No. 02-2448.

The application has an international filing date of 28 September 1999 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **26 July 2002**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (703) 308-6457